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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,978	08/21/2000	Norman William MacLeod	P0557/7030	6678

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EXAMINER

LEE, EDMUND H

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 01/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/581,978

Applicant(s)

MACLEOD, NORMAN WILLIAM

Examiner

EDMUND H LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-54 is/are pending in the application.
- 4a) Of the above claim(s) 24-40 and 50-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-23, 41-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 24-40 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 10.
2. Applicant's election of group I (claims 21-23) in Paper No. 10 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. New claims 50-54 have been grouped with the non-elected invention because it lacks the same or corresponding special technical feature as group I. Group I unlike group II does not require that the last be formed predominately of plastic. Therefore, claims 24-40 and new claims 50-54 have been withdrawn from further consideration as being drawn to a non-elected invention.
4. An examination on the merits of claims 21-23 and 41-49 has been set forth below.
5. Claims 22-23 and 48-49 are objected to because of the following informalities: these claims are identical to each other. Both sets of claims are dependent on independent claim 21. Appropriate correction is required.
6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Hardy (USPN 2878523). Hardy teaches the claimed method including a method of making an item of footwear such as a shoe (figs 7-8); forming an upper for the item of the footwear on a forming last (col 2, lns 5-23; figs 7-8); using a last including a body having the general shape of a foot around which the upper is to be formed, wherein the body has a base corresponding to a sole of the foot shape (figs 7-8); molding a rubber sole onto the formed upper while it is still mounted on the forming last, wherein the forming last is heated before and during the molding step (col 5, lns 32-35; col 9, ln 70-col 10, ln 2; figs 7-8); and heating the base of the last body while substantially preventing the heating of the parts of the body other than the base (col 12, lns 70-col 13, ln 3; figs 7-8). Hardy also teaches forming the upper on the last in a series of separate operations (col 5, ln 70-col 6, ln 13)--as a note, Hardy's steps of placing the upper on the last, tightening the draw string, and temporarily lacing the upper on the last constitute a series of separate operations; mounting the last on an apparatus for molding a rubber sole (fig 16); and moving the last with the formed upper thereon to a molding workstation of the apparatus (fig 16).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 22-23 and 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardy (USPN 2878523) as applied to claim 21 and further in view of Foffano et al (USPN 5955017). The above teachings of Hardy are incorporated hereinafter. Hardy also teaches placing the last with the upper thereon adjacent a mold assembly having a plurality of mold parts (figs 7-8); arranging the mold parts adjacent the base of the last and the upper thereon to define a mold cavity for the rubber sole (figs 7-8); placing a sole blank into the mold cavity (figs 7-8); applying heat and pressure to the rubber sole blank in the cavity to form the sole in adherence to the upper (col 11, ln 71-col 12, ln 8; figs 7-10); and heating the mold parts before and/or during the formation of the rubber sole to vulcanize the rubber (col 6, lns 29-53; col 9, ln 70-col 10, ln 2). However, Hardy does not teach injecting the rubber. Foffano et al teach a method of making an item of footwear (figs 1-6); injecting rubber into a mold cavity formed by a plurality of mold parts including a last having an upper thereon (col 2, lns 60-67; figs 1-6); and using heat and pressure applied to the rubber to form the sole (col 4, lns 3-col 6, ln 8; figs 1-6). Hardy and Foffano et al are combinable because they are analogous with respect to making footwear by heating and pressuring rubber against a last having an upper thereon. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to inject rubber as taught by Foffano et al instead of placing a rubber blank into the mold cavity of Hardy in order to reduce the cycle time of the molding process of Hardy.

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10. Claims 41-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardy (USPN 2878523) as applied to claim 21 and further in view of Foffano et al (USPN 5955017). The above teachings of Hardy are incorporated hereinafter. Hardy also teaches providing the upper with a base to which the rubber sole is to be attached (fig 6-8)--as a note, the portion of the upper placed the edge of the last constitutes a base; rotating a turntable of the apparatus on which the last has been mounted (fig 16); using a last having a base that includes at least one metal plate member extending at least partially over the base of the last body to which heat is transmissible from heating means located within the last such that the step of heating the forming last comprises heating the at least one metal plate member (col 12, ln 70-col 13, ln 3; figs 6-8); using a last having insulation means between the at least one metal plate member and the rest of the last body to substantially prevent heating of parts of the body other than the base (col 12, ln 70-col 13, ln 3; figs 6-8); using a heating means that includes at least one electrically activated heating element located inside the last adjacent an inner surface of the at least one plate member, and activating the least one heating element (col 12, ln 70-col 13, ln 3; figs 6-8); using a forming last includes an electrical terminal at a top surface thereof for electrically connecting the at least one heating element to a power supply (fig 16); and using a last having a heel portion and a toe portion (figs 6-8). Hardy does not teach moving the last sequentially through a plurality of separate workstations on the apparatus and performing fabrication operations at each of the workstations; engaging the electrical terminal in a bayonet type coupling; separating the heel portion and the toe portion to facilitate removal of a finished footwear. In regard to moving the

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last sequentially through a plurality of separate workstations on the apparatus and performing fabrication operations at each of the workstations, production line/assembly lines are well-known in the molding art in order to efficiently produce a finished product. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to redesign the apparatus of Hardy into a production/assembly line in order to efficiently produce a finished footwear. In regard to engaging the electrical terminal in a bayonet type coupling, such is well-known in the molding art in order to facilitate swapping or replacing of molding tools. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to redesign the last of Hardy to allow for engagement with a bayonet type coupling and to engage the electrical terminal of Hardy in a bayonet type coupling in order to achieve the above result. In regard to separating the heel portion and the toe portion to facilitate removal of a finished footwear, molding tools having separable portions are well-known in the molding art in order to facilitate removal of a molding article. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to redesign the heel and toe portions of the last of Hardy to allow for separation in order to facilitate removal of the finished footwear.

11. Applicant's arguments filed 10/24/02 have been fully considered but they are not persuasive. Applicant's arguments are not proper because they concern limitations that are not found in the instant claims. For instance, Applicant argues the impropriety of using string-lasting for heavy-duty materials; and using an insole with the last of Hardy. However, the instant claims do not mention the use of heavy-duty materials and an

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insole. As a note, Hardy teaches that an insole can be used with the last (col 6, Ins 10-15).

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Examiner Edmund Lee whose telephone number is (703) 305-4019. The examiner can normally be reached on Monday-Wednesday and Friday from 8:00 AM to 4:00 PM. The fax number for Examiner Edmund Lee is (703) 872-9615


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan H. Silbaugh, can be reached on (703) 308-3829.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

EHL

December 30, 2002


Edmund Lee *12/30/02*
Patent Examiner, AU 1732